

REMARKS

Applicants respectfully requests reconsideration of the above referenced patent application in view of the amendments and remarks set forth herein, and respectfully request that the Examiner withdraw all rejections. Claims 1, 9, 14, 17, 19, 20 and 22 have been amended. No claims have been canceled. No claims have been added. Thus, claims 1, 3-7, 9-12, 14-20 and 22-25 are pending.

Claim Objections

The Office Action objects to claim 19 for use of an improper claim identifier. The claim identifier of claim 19 accurately indicates that the claim is currently amended. Therefore, Applicants respectfully request that this objection be withdrawn.

35 U.S.C. §101 Rejections

The Office Action rejects claims 17-20 under 35 U.S.C. §101 as being directed toward non-statutory matter. More particularly, the Office Action alleges that each of independent claims 17, 19 and 20 is directed to merely functional descriptive material and a non-statutory signal. Applicants traverse the above rejection for at least the following reasons.

Currently amended claim 17 recites in a salient portion (emphasis added):

“An apparatus for distributing enhancement data for a television broadcast over a data network, comprising a **computer**-readable medium having instructions encoded thereon which when executed by one or more processors cause the one or more processors to perform:...”

Claims 19 and 20 are each amended herein to recite a similar preamble. Therefore, Applicants respectfully submit that the claims as amended are not directed to merely functional descriptive material. Furthermore, Applicants amend the specification herein to remove references to wired and wireless transmission environments, cited in the Office

Action. Therefore, Applicants submit that the claims as currently amended are directed to statutory subject matter. For at least the foregoing reasons, Applicants respectfully request that the 35 U.S.C. §101 rejection of remaining claims 17-20 be withdrawn.

35 U.S.C. §102 Rejections

35 U.S.C. §102(b) Rejection over *Hidary*

The Office Action rejects claims 1, 4, 9-11, 14, 15, 17, 20 and 22-24 under 35 U.S.C. §102(b) as being anticipated by *Hidary et al.*, U.S. Patent Number 5,778,181 (*Hidary*). The Office Action alleges that *Hidary* discloses, *inter alia*, a method for distributing enhancement data including converting the enhancement data into a second format.

The above rejected claims include independent claims 1, 9, 14, 17, 20 and 22. Currently amended claim 1 recites in a salient portion (emphasis added):

“...**selecting a second format** compatible with a second transport different from the first transport, wherein the second transport is the data network;...”

Each of claims 9, 14, 17, 20 and 22 recite similar claim limitations. Applicants submit that each of the above rejected claims is not anticipated by *Hidary* based at least on a failure of the reference to disclose at least one limitation of the independent claims – e.g. **selecting** a second format compatible with a second transport different from the first transport, wherein the second transport is the data network. In rejecting claim 6, 7 and 19 under 35 U.S.C. §103(a), the Office Action states:

“*Hidary* is silent on inspecting a client profile associated with the client, and determining the second format based at least in part on said inspecting.”

Applicants agree that *Hidary* is **silent** as to inspecting a client profile associated with the client, and determining the second format based at least in part on said inspecting. Applicants respectfully submit that *Hidary* is **similarly** silent as to selecting a second

format compatible with a second transport different from the first transport, wherein the second transport is the data network.

Hidary describes uniform resource locators (URLs) encoded into a video signal which is received by a URL decoder. From col. 4, ll. 46-58:

“...When the decoder 24 receives the video program signal, it strips out the URL codes on line 21 of the VBI and delivers these codes independently to an Internet server 28. The URL code is then subsequently delivered over the Internet 20 to the user PC 16....”

Hidary only discloses the stripping of **URLs** from a video signal, which are then delivered to a PC or an Internet server. The Office Action does **not** contend that the URL format is ever **selected** in *Hidary*, nor is such selecting ever disclosed by the reference. Nothing in the passages cited by the Office Action or elsewhere in *Hidary* discloses the URL decoder or any other component as **selecting** a second format compatible with a second transport different from the first transport, wherein the second transport is the data network, as variously recited in each of the independent claims.

Accordingly, currently amended independent claims 1, 9, 14, 17, 20 and 22 each contain at least one limitation not found in *Hidary*, and are not anticipated by *Hidary*. Furthermore, in depending directly or indirectly from one of these independent claims, each of dependent claims 4, 10-11, 15, 23 and 24 incorporate at least one limitation not found in the reference. Therefore, Applicants request that the rejection of claims 1, 4, 9-11, 14, 15, 17, 20 and 22-24 under 35 U.S.C. §102(b) based on *Hidary* be withdrawn.

35 U.S.C. §103(a) Rejections

35 U.S.C. §103(a) Rejection over *Hidary* and *ATVEF*

The Office Action rejects claims 3, 5, 12, 16, 18 and 25 under 35 U.S.C. §103(a) as being unpatentable over *Hidary* in view of Advanced Television Enhancement Forum Specification, draft, version 1.1r26 updated 2/2/99 (*ATVEF*). The above rejection relies

on the previously-discussed 35 U.S.C. §102(b) rejection of parent claims 1, 9, 14, 17 and 22 based on *Hidary*. In rejecting claims 3, 5, 12, 16, 18 and 25, the Office Action alleges that *ATVEF* discloses, *inter alia*, the use of ATVEF encoded web page content as enhancement data and pushing or pulling said data to a client. For at least the following reasons, Applicants traverse the above rejection.

As discussed previously, *Hidary* fails to disclose selecting a second format compatible with a second transport different from the first transport, wherein the second transport is the data network, as variously recited in each of the parent claims 1, 9, 14, 17 and 22. In rejecting the above claims for obviousness, the Office Action does not offer *ATVEF* as disclosing this limitation which is not taught or suggested by *Hidary*. Nor does the Office Action provide a new basis for *Hidary* teaching or suggesting this distinguishing limitation. Applicants respectfully submit that no combination of *Hidary* and *ATVEF* teaches or discloses selecting a second format compatible with a second transport different from the first transport, wherein the second transport is the data network, as variously recited in each of the independent claims.

In depending directly or indirectly from one of parent claims 1, 9, 14, 17 and 22, each of dependent claims 3, 5, 12, 16, 18 and 25 incorporate at least one limitation not taught or suggest by any combination of the cited references. Accordingly, the claims are non-obvious in light of the references and Applicants request that the rejection of claims 3, 5, 12, 16, 18 and 25 under 35 U.S.C. §103(a) based on *Hidary* and *ATVEF* be withdrawn.

35 U.S.C. §103(a) Rejection over *Hidary* and *Reynolds*

The Office Action rejects claims 6, 7 and 19 under 35 U.S.C. §103(a) as being unpatentable over *Hidary* in view of *Reynolds*. More particularly, the Office Action notes that *Hidary* fails to disclose inspecting a client profile associated with the client and determining the second format based at least in part on said inspecting, while *Reynolds* is alleged to disclose these limitations. For at least the following reasons, Applicants traverse the above rejection.

Applicants respectfully submit that claims 6, 7 and 19, are non-obvious in view of *Hidary* and *Reynolds*, based at least on a lack of motivation to combine the references to produce the variously claimed inventions of the independent claims. According to M.P.E.P. §2143.01 (emphasis added):

“Obviousness can only be established by **combining or modifying** the teachings of the prior art to produce the claimed invention where there is **some teaching, suggestion, or motivation to do so**. *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006).”

Applicants respectfully submit that there is **no motivation to combine** the *Hidary* and *Reynolds* to produce the claimed invention. In rejecting claims 6, 7 and 19, the Office Action states (page 10, line 18 to page 11, line 3):

“Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify *Hidary* by inspecting a client profile associated with the client, and determining the second format based at least in part on said inspecting as taught by *Reynolds* **in order to provide the content that best matches the capabilities of the viewer’s receiver**.” (Emphasis added)

Applicants are unable to reconcile the phrase “to provide the content that best matches the capabilities of the viewer’s receiver” with the subject matter of *Hidary* and *Reynolds*. More particularly, in order to **best match** capabilities of a viewer’s receiver, there must be some **variety** as to better (and worse) means of matching such capabilities. However, *Hidary* **does not teach or suggest** any variety for URLs which may be better (or worse) matched to the capabilities of a viewer’s receiver. Furthermore, Applicants note that *Reynolds* **makes no mention** of URLs, converting URLs or otherwise providing for receivers having differing capabilities to receive URLs. By contrast, the “content” in *Hidary* is **only** URLs, and the “viewer’s receiver” in *Hidary* is a PC suited to receive URLs. Therefore, *Hidary* is complete in itself. No “best matching of capabilities” is raised as an issue in *Hidary* vis-à-vis URLs. Insofar as *Hidary* offers a complete solution

for the scope of subject matter with which it concerns itself, there is **no motivation to combine** *Hidary* with *Reynolds*.

The lack of motivation to combine is further illustrated by the fact that the URL decoder of *Hidary* can be implemented locally **on the PC**. Implementing the URL decoder on the PC means that *Hidary* **teaches away** from a need to be modified or combined with another reference “in order to provide the content that best matches the capabilities of the viewer’s receiver”. This ostensible motivation to combine has **no meaning** when the invention in *Hidary* is **part** of the capabilities of the viewer’s receiver. Accordingly, Applicants respectfully submit that no combination of *Hidary* and *Reynolds* teaches or suggests inspecting a client profile associated with the client, and determining the second format based at least in part on said inspecting. Applicants therefore request that the 35 U.S.C. §103(a) rejection of claims 6, 7 and 19 be withdrawn.

CONCLUSION

For at least the foregoing reasons, Applicants submit that the objections and rejections have been overcome. Therefore, claims 1, 3-5, 7, 9-12, 14-18, 20 and 22-25 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application. Please charge any shortages and credit any overcharges to our Deposit Account No. 02-2666.

Respectfully submitted,
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